

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-11 and 13-20 remain in this application. Claim 12 has been withdrawn as the result of an earlier restriction requirement, and applicant retains the right to present that claim in a divisional application.

Claims 1-4 and 9-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Shuto *et al.* (U.S. 6,471,816). Claims 5-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shuto in view of Nagao *et al.* (U.S. 6,670,541). Claim 14 was rejected as being obvious in light of Shuto in view of Thedieck (U.S. 2,842,724). Claim 16 was rejected as being obvious in light of Shuto in view of Mimura (U.S. 6,182,403). Claims 17-19 were rejected as being obvious in light of Shuto in view of Thedieck. For the following reasons, the rejections are respectfully traversed.

First, claim 1 has again been amended to clarify various features that are not found in the cited reference. For example, claim 1 recites that the power generating product includes “a sealing material applied at an outer side of the blind hole, wherein said electric conductor is provided through said sealing material to said contact portion”, which is not found in Shuto. Instead, Shuto teaches that the openings 28 are completely filled with a conductive material 52, and that the conductor lead wire is connected to this conductive material (see col. 8, lines 37-42). Even in the section cited by the Examiner, the teaching is only that a lead wire 30 is soldered to the back side of the metal foil 22, referring to Fig. 6. That figure does not show any sealing material applied to an outer side of the blind hole, and the reference does not show the lead wire 30 being provided *through* the sealing material. The figure clearly shows that the lead wire 20 is attached to the

solder, without any suggestion that the wire is provided to the foil 22 *through* the sealing material. Thus, claim 1 is patentable over the reference for these reasons.

In addition, claim 1 recites that the blind hole has “lateral sides” that are even and a “bottom having an uneven surface at said contact portion with said electric conductor being connected to said uneven surface using a weld”. Nothing in the reference teaches any uneven bottom surface at the contact portion, and the reference clearly does not teach the conductor portion contacting the uneven surface (see Fig. 6 where it is clear that the conductor does not contact any uneven surface). The Examiner argues that Shuto teaches that the metal foil can be “slightly cut into” (referring to col. 5 lines 1-24), but such a teaching does not support that the surface is thereby uneven. By definition, the “metal foil 22” is very thin, and Shuto teaches that it is undesirable to cut through the metal foil (see col. 5, lines 14), and thus any chance of an “uneven surface” would make such a cut-through more likely, and thus undesirable.

Furthermore, one skilled in the art would know that cutting does not necessarily result in an uneven surface as means of cutting resulting in even surfaces are well known, and thus absent such an explicit teaching, the Examiner must argue that the teaching is implicit, which the Examiner cannot do because cutting can result in even or uneven surfaces, depending on the desired application and the cutting method. Thus, the surface would not be inherently uneven, and thus the Examiner cannot reject the claims on this basis.

Accordingly, for any of the above reasons, claim 1 is patentable over Shuto. Claim 17, as amended, recites a “sealing material applied at an outer side of the blind hole for sealing said blind hole, wherein said electric conductor is provided through said sealing material to said contact portion at said weld”. None of the other cited reference teach such a feature, and thus claim 17 is patentable over the references for at least this reason. Furthermore, claim 17 recites “said blind hole having: a bottom with a conical shape for receiving said electric conduct with said weld”. As discussed above, it is clear from the reference that the conductor is not “received” by the surface of Shuto, and thus claim 17 is patentable over that reference for this reason as well.

The remaining claims, which depend on one of claims 1 or 17, are patentable over the Shuto for at least the same reasons as their parent claims. Because the additionally cited references do not overcome the Shuto shortcomings, the claims are also patentable over the various combinations of references.

Finally, the Examiner has failed to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion or motivation* to modify the reference (MPEP §2143.01), or the Examiner must provide some other logical argument as to why the invention is obvious. Furthermore, the Examiner is required to *ascertain the level of skill in the art*, and then *factually analyze* why one skilled in the art, starting with the problem to be solved by the inventor, given the cited references, would have found it obvious to obtain the claimed invention. See *KSR Int'l Co. v. Teleflex*, 550 U.S. ____ (2007) (first paragraph of page 2 of the published opinion, citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)).

Thus, to be “obvious”, in addition to determining the scope and content of the prior art and the differences between the prior art and the claims, the Examiner must identify the *level of skill in the art* (see *KSR Int'l Co. v. Teleflex*, 550 U.S. ____ (2007) (first paragraph of page 2 of the published opinion, citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966))), and then he must show *why* one skilled in the art would arrive at the claimed invention, given these findings and the skill generally available to one skilled in the art (see *KSR* at pages 20-21 of the published opinion). This, the Examiner has not done, and thus the Examiner has failed to support a prima facie case of obviousness. In fact, the discussion above supports the fact that such modifications suggested by the Examiner are not within the skill of the art. Accordingly, the rejections for obviousness cannot stand.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

Appl. No. 10/688,596
Amdt. dated August 22, 2007
Reply to Office action of May 22, 2007

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 36202.

Respectfully submitted,
PEARNE & GORDON LLP

By: / Robert F. Bodi /
Robert F. Bodi, Reg. No. 48540

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

August 22, 2007